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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,320	04/21/2004	Daiji Kono	M1071.1910	4231
32172	7590	08/15/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			HAM, SEUNGSOOK	
			ART UNIT	PAPER NUMBER
			2817	

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,320

Applicant(s)

KONO ET AL.

Examiner

Seungsook Ham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/21/05, 4/21/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,853,268 in view of Miyakoshi et al. (US '396) or Umeda et al. (JP '944).

The structure of the electronic component/noise filter in the instant claims is broad to read on the patent claims. The patent claims do not include the specific composition for the nonmagnetic/dielectric member. Miyakoshi et al. (see abstract and col 5, lines 44-52) discloses a ceramic substrate made of the glass ceramic composite composition as the application's claimed invention. Umeda et al. (see abstract) also discloses a ceramic body made of the same glass ceramic composite composition as the applicant's claimed invention. It would have been obvious to one of ordinary skill in the art to use the ceramic member of Miyakoshi et al. or Umeda et al. as the nonmagnetic member in the patented claims to provide low dielectric constant, low

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dielectric dissipation factor or high insulation property as taught by Miyakoshi et al. (col. 1, lines 55-59) or Umeda et al. (see abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morii et al. (US '316) or Naito et al. (US '712) in view of Miyakoshi et al. (US '396) or Umeda et al. (JP '944).

Morii et al. (figs. 1-3) discloses an electronic component comprising: a magnetic member 18 comprising an iron oxide magnetic composition; a nonmagnetic member 12 in contact with the magnetic member; an internal conductor portion 14a, 14b, 20

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disposed at least one of the magnetic and the nonmagnetic members; external electrodes 22 electrically connected to the internal conductor portion.

Naito et al. (figs. 7-9) also discloses an electronic component comprising: a magnetic member 1 comprising an iron oxide magnetic composition; a nonmagnetic member 2, 3 in contact with the magnetic member; an internal conductor portion 4-8 disposed at least one of the magnetic and the nonmagnetic members; external electrodes 10, 11 electrically connected to the internal conductor portion.

Morii et al. or Naito et al. does not show the nonmagnetic/dielectric member made of a glass ceramic composite composition comprised of crystallized glass, SiO_2 - MgO - Al_2O_3 - B_2O_3 , as a main component and quartz as a sub-component filler.

Miyakoshi et al. (see abstract and col 5, lines 44-52) discloses a ceramic substrate made of the glass ceramic composite composition as the application's claimed invention. Umeda et al. (see abstract) also discloses a ceramic body made of the same glass ceramic composite composition as the applicant's claimed invention.

It would have been obvious to one of ordinary skill in the art to use the ceramic member of Miyakoshi et al. or Umeda et al. as the nonmagnetic member in the device of Morii et al. or Naito et al. to provide low dielectric constant, low dielectric dissipation factor or high insulation property as taught by Miyakoshi et al. (col. 1, lines 55-59) or Umeda et al. (see abstract).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harada (US 6,853,268) in view of Miyakoshi et al. (US '396) or Umeda et al. (JP '944).

Harada (figs. 1-4) discloses an electronic component/noise filter comprising: a plurality of adjacent magnetic layers/magnetic member 2a-2d; at least two opposed signal lines/internal conductor portion 3, 4 disposed between two adjacent magnetic layers of the plurality of adjacent magnetic layers; a dielectric/nonmagnetic member 7 provided between the at least two opposed signal lines; and at least two opposed ground electrodes 5A disposed on either side of the at least two opposed signal lines.

Harada do not include the specific composition for the nonmagnetic/dielectric member. Miyakoshi et al. (see abstract and col 5, lines 44-52) discloses a ceramic substrate made of the glass ceramic composite composition as the application's claimed invention. Umeda et al. (see abstract) also discloses a ceramic body made of the same glass ceramic composite composition as the applicant's claimed invention.

It would have been obvious to one of ordinary skill in the art to use the ceramic member of Miyakoshi et al. or Umeda et al. as the dielectric/nonmagnetic member in the device of Harada to provide low dielectric constant, low dielectric dissipation factor or high insulation property as taught by Miyakoshi et al. (col. 1, lines 55-59) or Umeda et al. (see abstract).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (US '517), Okubo (US '470) or Tokuda et al. (US '391) in view of Miyakoshi et al. (US '396) or Umeda et al. (JP '944).

Kaneko et al. (fig. 6) discloses an electronic component/noise filter comprising: a plurality of adjacent magnetic layers/magnetic member 1₁, 1₂ (see fig. 1); at least two opposed signal lines/internal conductor portion 7, 15 disposed between two adjacent

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magnetic layers of the plurality of adjacent magnetic layers; a dielectric/nonmagnetic member 21 provided between the at least two opposed signal lines; and at least two opposed ground electrodes 32, 33 (fig. 3) disposed on either side of the at least two opposed signal lines. Regarding claim 1, Kaneko et al. also shows external electrodes 30, 31 electrically connected to the internal conductor portions 2-6, 11-14, 23a-26a.

Okubo (figs. 13-19) also discloses an electronic component/noise filter comprising: a plurality of adjacent magnetic layers/magnetic member 1a-1d, 1f-1i (see figs. 1-4); at least two opposed signal lines/internal conductor portion 32, 33 (see fig. 15) disposed between two adjacent magnetic layers 1d, 1f of the plurality of adjacent magnetic layers; a dielectric/nonmagnetic member 30a-30d provided between the at least two opposed signal lines; and at least two opposed ground electrodes 41, 42 (see fig. 17) disposed on either side of the at least two opposed signal lines. Regarding claim 1, Okubo also shows external electrodes 43, 44 electrically connected to the internal conductor portions 32, 33, 21a, 21b.

Tokuda et al. (fig. 25) also discloses an electronic component/noise filter comprising: a plurality of adjacent magnetic layers/magnetic member 406; at least two opposed signal lines/internal conductor portion 403a, 403b disposed between two adjacent magnetic layers of the plurality of adjacent magnetic layers; a dielectric/nonmagnetic member 407 provided between the at least two opposed signal lines. Tokuda et al. is silent as to the location of the ground electrodes, however, providing ground electrodes on either side of the signal lines is considered as an obvious modification since it requires only a routine skill in the art to provide ground

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electrodes to obtain a desire signal response. Regarding claim 1, Tokuda et al. also shows external electrodes 3-6 (see fig. 1) electrically connected to the internal conductor portions 9a-10b.

Kaneko et al. Okubo or Tokuda et al. does not show the nonmagnetic/dielectric member made of a glass ceramic composite composition comprised of crystallized glass, $\text{SiO}_2\text{-MgO-Al}_2\text{O}_3\text{-B}_2\text{O}_3$, as a main component and quartz as a sub-component filler.

Miyakoshi et al. (see abstract and col 5, lines 44-52) discloses a ceramic substrate made of the glass ceramic composite composition as the application's claimed invention. Umeda et al. (see abstract) also discloses a ceramic body made of the same glass ceramic composite composition as the applicant's claimed invention. It would have been obvious to one of ordinary skill in the art to use the ceramic member of Miyakoshi et al. or Umeda et al. as the nonmagnetic member in the device of Kaneko et al. or Tokuda et al. to provide low dielectric constant, low dielectric dissipation factor or high insulation property as taught by Miyakoshi et al. (col. 1, lines 55-59) or Umeda et al. (see abstract).

Regarding claim 8, the signal lines having meandering shape is considered as an obvious design modification since such signal line is well known in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Kishida et al., and Sudo et al. disclose a crystallized glass composition comprises of SiO_2 - MgO - Al_2O_3 - B_2O_3 ; and

Yamamoto et al. (fig. 16) discloses a noise filter having a signal line having a meandering shape.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seungsook Ham whose telephone number is (571) 272-2405. The examiner can normally be reached on Monday-Thursday, 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pascal can be reached on (571)-272-1769. The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Seungsook Ham
Primary Examiner
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